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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,470	08/06/2001	Edward J. Grenchus JR.	END920010061US1	1539
7590	05/25/2006		EXAMINER	
Shelley M Beckstrand Patent Attorney 61 Glenmont Road Woodlawn, VA 24381-1341			LOFTIS, JOHNNA RONEE	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/923,470	GRENCHUS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Johnna R. Loftis	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 18 March 2006.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-32 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 8/6/01, 1/9/06.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. The following is a final office action upon examination of application number 09/932,470. Claims 1-32 are pending and have been examined on the merits discussed below.

### ***Response to Arguments***

2. Applicant's arguments filed 3/18/06 have been fully considered but they are not persuasive. With respect to arguments regarding previous rejections under 35 USC 101 and 35 USC 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs, Examiner disagrees. As stated in 35 USC 101, for an invention to be statutory, it must be useful, concrete and tangible. In this case, even though one of ordinary skill in the art understands that, for example, a lap top is less complex than a desk top, one is still precluded from being able to objectively determine a complexity factor so as to enable one to then determine staffing requirements and productivity targets. There is no predefined criteria or algorithm to determine a complexity factor in a concrete way. Applicant states that the complexity factor is related to the time it takes for an experienced operator to tear down a particular piece of equipment. However, this is not supported in the specification. The specification states that easily disassembled equipment will have a lower complexity factor. Here complexity seems related to difficulty, not time taken to disassemble. Since based on the specification and arguments, it is even more unclear how a complexity factor is determined, Examiner asserts that one of ordinary skill in the art would not be able to determine a complexity factor without guidelines or criteria. Furthermore, if the complexity factor is not described in such a way to enable one of ordinary skill in the art to assign a complexity factor during disassembly, Examiner asserts that one of ordinary skill in the art would not be able to determine

staffing requirements and productivity targets based on this complexity factor in a way that is useful and concrete. In further support of Examiners position, the example set forth in the remarks section, wherein Applicant provides the example wherein complexity is ranked on a scale from one to ten, is not supported in the specification.

3. Also with respect to rejections under 35 USC 101 regarding the subjectivity of determining salvageable and disposable content, Examiner stresses that there needs to be concrete guidelines in place for determining salvageable and disposable content. As claimed, without any predefined criteria distinguishing between salvageable and disposable goods, one of ordinary skill in the art would not be able to carry out the invention as intended. As disclosed, the method of determining salvageable or disposable contents is completely subjective since depending on who is making the determination; the same part or item could be deemed as salvageable or disposable.

4. The rejections of claim 32 under 35 USC 101 regarding the program product not being executable and no recitation of having instructions stored in a computer readable medium have been withdrawn

5. Regarding previous rejections to claims 16-18 under 35 USC 112, 2<sup>nd</sup> paragraph, there needs to be structural system elements recited. As claimed, the model, further described as a Lotus 1-2-3 spreadsheet, while implemented on a computer, only refers to a collection of data and/or formulas. Previous rejections under 35 USC 112, 2<sup>nd</sup> paragraph are upheld. Previous rejection to claim 17 is upheld as well. The claimed database is nothing more than a collection of data, which does not include structural elements.

***Information Disclosure Statement***

6. The information disclosure statements (IDS) submitted on 8/6/01 and 1/9/06 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

***Claim Rejections - 35 USC §101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

8. Claims 1-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the invention is not concrete since the claimed complexity factor is not fully described so that one of ordinary skill in the art would know how to determine the complexity factor thereby leading to non-repeatable results in determining the complexity factor and staffing requirements. Since the invention is not concrete, the staffing requirements that are determined are not useful and are not tangible. Furthermore, in claim 8, the step of determining salvageable and disposable content is also not described in such a way that one skilled in the art would be able to make the determination. Specifically, there are no set guidelines for determining what characteristics make some material content salvageable and some material content disposable. As disclosed, the method of determining salvageable or disposable contents is completely subjective since depending on who is making the determination; the same part or item could be deemed as salvageable or disposable.

Since the recited process produces neither a useful, concrete, nor tangible result, claims 1-32 are deemed non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the determination of the complexity factor is not described in such a way to enable one skilled in the art to make and/or use the invention. The only explanation of the complexity factor describes it as being determined by disassembly prototyping, which is completely subjective. The difficulty of disassembling material can be viewed differently depending on who or what is performing the disassembly. The complexity factor is subjective in that it is not fully described how one would disassemble or dismantle material and determine the complexity without some type of guidelines explaining what determines the level of complexity. Without fully understanding how to determine the complexity factor, one would also not be enabled to determine the staffing requirements.

11. Furthermore, the step of determining salvageable and disposable content is also not described in such a way to enable one skilled in the art to make/and or use the invention. Specifically, there are no set guidelines for determining what material content should be salvaged and what material content should be disposed of. As disclosed, the method of determining salvageable or disposable contents is completely subjective since depending on who is making the determination; the same part or item could be deemed as salvageable or disposable.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the determination of the complexity factor is unclear since there it is not fully disclosed how one of ordinary skill in the art would disassemble material and determine a complexity factor without some type of guidelines explaining what determines the level of complexity. The only explanation of the complexity factor describes it as being determined by disassembly prototyping, which is completely subjective. The difficulty of disassembling material can be viewed differently depending on who or what is performing the disassembly.

14. Also, the step of determining salvageable and disposable content is also not described in such a way to enable one skilled in the art to make/and or use the invention. Specifically, there are no set guidelines for determining what material content should be salvaged and what material content should be disposed of. As disclosed, the method of determining salvageable or

disposable contents is completely subjective since depending on who is making the determination; the same part or item could be deemed as salvageable or disposable.

15. Claims 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Claims 16-18 recite no structural system elements. A system is treated as an apparatus as defined by its structural limitations, however, claims 16-18 recite no structural elements. For example, in claims 16 and 18, the claimed model is construed as a collection of data or formulas and, in claim 17 it is questionable what the structure of the database is. Clarification is required.

### *Conclusion*

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Loftis whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JL  
5/19/06

*Susanna Diaz*  
SUSANNA M. DIAZ  
PRIMARY EXAMINER

*AU 3623*